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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,786	08/30/2001	Maria Azua Himmel	AUS920010628US1	9749
34533	7590	11/26/2004	EXAMINER	
IBM CORP (BLF) c/o BIGGERS & OHANIAN, LLP 504 LAVACA STREET, SUITE 970 AUSTIN, TX 78701-2856			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/942,786

Applicant(s)

HIMMEL ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-35 are pending in the instant application.

### ***Drawings***

The drawings were received on 10/6/2004. The Examiner accepts these drawings.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Mourad Patent Application Publication No. US 2003/0135464.**

Referring to claim 1. Mourad discloses a method of online shopping comprising the steps of:

- Purchasing an electronic item from a merchant web site (at least paragraph 0282);

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- Wherein the purchasing is carried out by use of a client shopping cart that collects item information from the merchant web site prior to checkout (at least paragraph 0282 and paragraph 0902),
- Wherein the client shopping cart further comprises a merchandise pickup facility installed on a client (at least paragraph 0980, "Cache Manager"), and
- Wherein the client is coupled for data communications to the merchant web site (at least Figure 5);
- Downloading, to the client, the electronic item through the merchandise pickup facility on the client (at least paragraph 1233); and
- Installing the electronic item through the merchandise pickup facility on the client (at least paragraph 1233).

Referring to claim 2. Mourad further discloses a method wherein the merchandise pickup facility comprises application software integrated within the client-shopping cart (at least paragraph 1233).

Referring to claim 3. Mourad further discloses a method wherein the merchandise pickup facility comprises a data communications software application installed upon the client and connected to the client-shopping cart through an interface (at least Figure 7).

Referring to claim 4. Mourad further discloses a method wherein the merchandise pickup facility comprises software integrated within the client as a plug-in wherein the merchandise pickup facility is connected to the client-shopping cart through an interface (at least paragraph 1122).

Referring to claim 5. Mourad further discloses a method wherein downloading the electronic item comprises downloading the electronic item to the client through a service provider site upon which is installed a remote merchandise pickup facility (at least paragraph 0133).

Referring to claim 6. Mourad further discloses a method comprising scheduling the downloading (at least paragraph 0133).

Referring to claim 7. Mourad further discloses a method wherein the downloading is performed in accordance with a predefined schedule, wherein the schedule is stored in computer memory on the client (at least paragraph 0133).

Referring to claim 8. Mourad further discloses a method wherein the client has a temporary web address.

The Examiner notes, the status of the web address (temporary or permanent) are not functionally involved in the steps recited. The method steps would be performed the same regardless of the status of the web address. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Referring to claim 9. Mourad further discloses a method wherein the client has a permanent web address (at least paragraph 0004 through paragraph 0020).

The Examiner notes, the status of the web address (temporary or permanent) are not functionally involved in the steps recited. The method steps would be performed the same regardless of the status of the web address. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Referring to claim 10. Mourad further discloses a method wherein the downloading is performed in accordance with a predefined schedule, wherein the schedule is stored in computer memory on the merchant web site (at least paragraph 1233).

Referring to claim 11. Mourad further discloses a method wherein the client has a permanent web address (at least paragraph 0004 through paragraph 0020).

The Examiner notes, the status of the web address (temporary or permanent) are not functionally involved in the steps recited. The method steps would be performed the same regardless of the status of the web address. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Referring to claims 12-22. Claims 12-22 are rejected under the same rationale as set forth above in claims 1-11

Referring to claims 23-33. Claims 23-33 are rejected under the same rationale as set forth above in claims 1-11

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mourad Patent Application Publication No. US 2003/0135464 in view of Ferguson U.S. Patent Number 5,966,697.**

Referring to claim 34. Mourad discloses a method according to claim 1 as indicated supra. Mourad does not expressly disclose a method wherein the client shopping cart contains item information for another electronic item from another website. Ferguson discloses a method wherein the client shopping cart contains item information for another electronic item from another website (at least Abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Mourad to have included the teachings of Ferguson as discussed above in order to provide a system and method for shopping at a variety of different vendors easily and securely (Ferguson: column 2, lines 16-27).

Referring to claim 35. Mourad discloses a method according to claim 1 as indicated supra. Mourad does not expressly disclose a method comprising exposing item information for another electronic item from another website to the merchant web site. Ferguson discloses a method comprising exposing item information for another electronic item from another website to the merchant web site (at least Abstract). At the

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time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Mourad to have included the teachings of Ferguson as discussed above in order to provide a system and method for shopping at a variety of different vendors easily and securely (Ferguson: column 2, lines 16-27).



***Response to Arguments***

Applicant's arguments filed 10/6/04 with respect to claims 1-33 have been fully considered but they are not persuasive.

Applicant's arguments filed 10/6/04 with respect to claims 34-35 are moot in view of the new grounds of rejection.

The Applicant argues that Mourad does not disclose each and every element of independent claim 1.

The Applicant argues that Mourad does not disclose the steps of purchasing an electronic item from a merchant web site wherein the purchasing is carried out by use of a client shopping cart that collects item information from the merchant web site prior to checkout.

The Examiner notes, when the End-User submits the final purchase authorization to the Electronic Digital Content Store for the merchandise (item information) he has collected in his shopping cart, his Web Browser remains active waiting for a response from the Web Server. The Web Server at the Electronic Digital Content Store processes (checkouts) the purchase and performs the financial settlement and then returns a Transaction SC(s) to the End-User Devices (at least paragraph 1002). This processing function takes place after the shopping cart has collected merchandise item information.

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The Applicant argues that Mourad, paragraph 1233, does not disclose installing an already downloaded electronic item through a merchandise pickup facility which is already installed on the client.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Examiner notes, when an End-User finds content that they want to buy, they click on a content icon, and the item is added to his/her shopping cart which is maintained by the Electronic Digital Content Store. When the End-User completes shopping they submit the purchase request to the Electronic Digital Content Store for processing. After processing a Transaction SC is then transmitted to the End-User Device. When the Transaction SC arrives on the End-User device, it kicks off the End-User Player Application (already installed on the client), which opens the Transaction SC and acknowledges the End-User's purchase. The End-User Player Application then opens the individual Offer SCs and in an alternate embodiment, may inform the user with an estimate of the download time (at least paragraph 0282 through paragraph 0287). The End-User Player Application even though not called a "Merchandise pickup

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facility" is functionally equivalent to the merchandise pickup facility claimed in the instant invention.

The Applicant argues that Mourad does not enable independent claim 1.

The Examiner notes, the prior art is presumed to be operable/enabling. When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07. The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other.

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### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

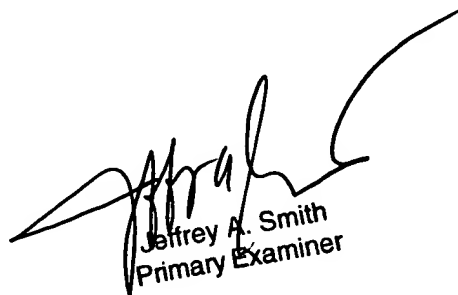
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG  
Patent Examiner  
June 16, 2004



Jeffrey A. Smith  
Primary Examiner